



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,349	06/05/2001	John C. Hiserodt	IRVN001DIV	8040

24353 7590 05/11/2006

BOZICEVIC, FIELD & FRANCIS LLP  
1900 UNIVERSITY AVENUE  
SUITE 200  
EAST PALO ALTO, CA 94303

EXAMINER
----------

YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
----------	--------------

1643

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/875,349	<b>Applicant(s)</b> HISERODT ET AL.	
	<b>Examiner</b> Christopher H. Yaen	<b>Art Unit</b> 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 31-48, 50 and 52-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-48, 50, 52-54, 65-77 and 82 is/are rejected.
- 7) ☐ Claim(s) 55-64 and 78-81 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

**RE: Hiserodt *et al***

1. Claims 1-30,49, and 51 are canceled, claims 31-48,50, and 52-82 are pending and examined on the merits.

## NEW REJECTIONS

### ***Claim Rejection - 35 U.S.C 135***

2. Claims 31-48,50,52-54,65-77, and 82 are rejected under 35 U.S.C. 135(b) as being made more than one year from the date on which U.S. Patent No. 5,891,432 (Soo Hoo, W. 4/6/1999) was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632,1635 (Fed. Cir. 1997) where the Court held that the application of 35 U.S.C. 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections. Specifically, the claims of the instant application are drawn to a pharmaceutical composition comprising a human cell expressing a cytokine and a pharmaceutical composition, wherein the cytokine comprises a heterologous transmembrane region. The claims of the issued US Patent 5,891,432 are drawn to a pharmaceutical composition comprising a cell having a membrane bound fusion protein comprising GM-CSF fused to a heterologous membrane attachment domain.

The obviousness test is not the standard for determining whether the subject matter is the same or substantially the same. Rather the determination turns on the presence or absence of a different material limitation in the claim. These tests are distinctly different. The analysis focuses on the interfering claim to determine whether all

Art Unit: 1643

material limitations of the interfering claim necessarily occur in a prior claim. In re Berger, 279 F.3d 975, 61 USPQ2d 1523 (Fed. Cir. 2002). In the instant case, the claimed limitation of a cell expressing a "heterologous transmembrane region" was not claimed in this or in any of the previously filed applications within one year of the issue date of (i.e. 08/901,225; 60/023108; or 60/029,286) from which the instant application claims priority.

### ***Conclusion***

No claim is allowed. Claims 55-64 and 78-81 are objected to for depending on rejected claims.

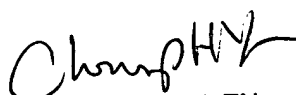
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Yaen whose telephone number is 571-272-0838. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, Ph.D. can be reached on 571-272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1643

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Yaen, Examiner  
Art Unit 1643  
April 20, 2006

  
CHRISTOPHER YAEN  
PATENT EXAMINER